

## REMARKS

In accordance with the foregoing, claims **1-8**, and **10-15** are pending and under reconsideration, which is respectfully requested.

### ITEMS 4-5: NONSTATUTORY DOUBLE PATENTING REJECTION.

The Examiner asserts that Claims **1-4**, **8** and **10-14** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **11** and **12** of U.S. Patent No. 7,029,825 B2.

The Examiner states that a timely filed disclaimer may be used to overcome the rejection. However, the terminal disclaimer regarding the potential confliction to with US Patent No. 7,029,825 B2 was filed on August 21, 2006 and has been accepted by Patent Office. Enclosed is a "terminal disclaimer approved form used within the USPTO" that was entered into the image file wrapper on September 13, 2006. An annotated listing of the image file wrapper is also enclosed to show that a terminal disclaimer was filed and accepted. It should be noted that, when the August 21, 2006 documents were filed, the patent office switched the last pages of the terminal disclaimer and the amendment. However, both were clearly filed as evidenced by the terminal disclaimer being approved.

According to foregoing, the nonstatutory double patenting rejection should be withdrawn.

### ITEM 6-7: REJECTION OF CLAIMS 1-8 AND 10-15 UNDER 35 U.S.C. 102(e) AS BEING ANTICIPATED BY YOKOTA ET AL. (US 2004/0157162 A1).

35 USC §102(e) states that an international application filed under the treaty defined in §351(a) shall have the effect for the purposes of this subsection of an application filed in United States only if the international application designated the United States and was published under article 21(2) of such treaty in the English language.

U.S. Patent Publication No. 2004/0157162 A1 (hereinafter referred to as "US '162") is a U.S. application publication of an International Application No. PCT/JP02/08811 filed on August 30, 2002 in the Japanese language. Accordingly, International Application No. PCT/JP02/08811 was published as WO/2003/022594 on March 20, 2003 in the Japanese language (see a copy of the Bibliographic Data of WO/2003/022594 which is attached hereto).

Since the PCT publication of US '162 is not in English, US '162 is not available as prior art under 35 USC 102(e).

In addition, the present application claims priority to Japanese Patent Application No. 2002-184808 filed on June 25, 2002 and Japanese Patent Application No. 2003-055935 filed on March 3, 2003. The filing date of each of the two Japanese priority applications is prior to the PCT publication of US '162 which is March 20, 2003. Since the claims of the present application are at least partly entitled to the benefit of the priority dates, neither US '162 nor the PCT publication WO/2003/022594 corresponding to US '162 can be used as a reference for rejection under 35 USC 102.

In support of this argument, Applicants submit herewith verified English translations of the two Japanese priority applications, namely Japanese Patent Application No. 2002-184808 (hereinafter referred to as the "first priority application") and Japanese Patent Application No. 2003-055935 (hereinafter referred to as the "second priority application"). Further explanation is made below with respect to the relationship between the two priority applications and claims 1-8 and 10-15 on file.

Claim 1 of the present application is directed to a laser engravable printing element characterized by the use of a specific resin composition. The resin composition comprising components (a), (b) and (c) is described in claim 1 of the first priority application; the amounts of components (a), (b) and (c) are described in paragraph [0032] of the first priority application; and the number average molecular weights of components (a) and (b) are described in claim 2 of the first priority application. With respect to component (c), the average pore diameter and pore volume are described in claim 1 of the first priority application, and the number average particle diameter is described in claim 1 of the second priority application. Further, the method for obtaining the laser engravable printing element is described in claim 6 of the first priority application.

Claim 2 of the present application recites the specific surface area and oil absorption value of component (c), and this claim is supported by claim 1 of the first priority application.

Claims 3 and 4 of the present application correspond to claims 3 and 4 of the first priority application, respectively.

Claim 5 of the present application recites the use of spherical particles or regular polyhedral particles, and this claim is at least in part supported by paragraph [0030] of the first priority application.

Claim 6 of the present application corresponds to claim 6 of the second priority application.

Claim 8 of the present application recites the use of the laser engravable printing element for forming a relief printing element, and this claim is supported by paragraph [0051] of the first priority application.

Claims 10 and 11 of the present application correspond to claims 7 and 8 of the first priority application, respectively.

Claim 12 of the present application is directed to a method for producing a laser engravable printing element which is characterized by the use of a specific resin composition. This claim corresponds to claim 10 of the second priority application, but is also supported by the first priority application. Specifically, as explained above in connection with claim 1, the specific resin composition is supported by claims 1 and 2 and paragraph [0032] of the first priority application. Further, steps (i), (ii) and (iii) are supported by paragraphs [0036], [0040] and [0052] of the first priority application, respectively.

Claim 13 of the present application correspond to claim 11 of the second priority application.

Claim 14 of the present application recites the use of a photopolymerization initiator, and this claim is supported by paragraph [0035] of the first priority application.

Claim 15 of the present application is directed to a laser engravable printing element characterized by the use of a specific resin composition. Component (a) which is a styrene-butadiene copolymer resin having a number average molecular weight of from 10,000 to 100,000 is supported by paragraphs [0014] and [0019] of the first priority application; component (b) which is a methacrylate organic compound having a number average molecular weight of less than 5,000 is supported by paragraph [0020] of the first priority application; and component (c) which is silica inorganic porous particle is supported by paragraph [0024] of the first priority application. With respect to component (c), the average pore diameter is described in paragraph [0032] of the second priority application; the pore volume, specific surface area and oil absorption value are described in claim 1 of the first priority application; the number average particle diameter is described in claim 1 of the second priority application; and the use of spherical particles or regular polyhedral particles is at least in part supported by paragraph [0030] of the first priority application. Further, the method for obtaining the laser engravable printing element is described in claim 6 of the first priority application.

With respect to claims 5, 7 and 15 of the present application, the use of regular polyhedral particles and the  $D_3/D_4$  value thereof are not specifically described in the two priority applications. However, US '162 also has no teaching or suggestion about the use of regular polyhedral particles or the  $D_3/D_4$  value thereof. Specifically, US '162 only discloses that "there is no particular limitation with respect to the shape of the particles of inorganic porous material (c), and each particle of inorganic porous material (c) may independently be in the form of a sphere, a plate or a needle" (see paragraph [0081] of US '162). It is important to note that paragraph [0081] of US '162 is the same as the description found in paragraph [0030] of the first priority application of the present application (see page 30, lines 8-19 of the English translation of the first priority application).

Therefore, claims 5, 7 and 15 of the present application are neither anticipated by nor obvious in view of US '162.

As apparent from the explanation above, the subject matter of each of the claims of the present application is patentable under 35 U.S.C. 102.

### CONCLUSION

Thus, it is believed that all rejections have been removed, and the present application is now in condition for allowance.

Reconsideration and early favorable action on the claims are earnestly solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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